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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/091,904 | 03/05/2002 | John D. Boardman | 064747.0961 | 9395 |

5073 7590 01/15/2003

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EXAMINER

LE, QUE TAN

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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2878

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,904

Applicant(s)

BOARDMAN ET AL.

Examiner

Que T. Le

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-28 of U.S. Patent No. 6,396,042. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention, claims 1-19, of the present application is a broader version of the claimed invention, claims 12-28, of the above identified U.S. Patent with similar intended scope.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Keightley 5,363,217.

Keightley discloses an image transfer system comprising: a cylinder (21) slidably coupled to a translation stage and having a curved writing surface or platen (22); a rotatable shaft with motor (16) having at least a first reflective surface (40); and a light source (10, 11) emitting a beam of light to the reflective surface for reflection to the writing surface. The shaft includes a multiple reflective surfaces.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5-7 and 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keightley 5,363,217.

With respect to claim 2, although Keightley fails to specify the type of the shaft, selecting the use of an available known such as an air-bearing supporting shaft in a scanning system would have been obvious to one of ordinary skill in the art. It would have been obvious to modify Keightley accordingly in order to provide a better rotatable element for the scanning operation of the system.

With respect to claims 5, 6, and 10, although Keightley lack an inclusion of continuously rotation, a setting and/or a specific rotating cycle (direction) of the shaft as claimed, selecting a particular rotation operation of a rotatable shaft in a scanning system in order to provide an desired scanning performance depend upon a selected scanned object and/or configuration of the recording surface. It would have been obvious to one of ordinary skill in the scanning art at the time of the invention to modify Keightley accordingly in order to provide more accurate scanning performances of the system. Selecting a galvanometer and/or a motor or any available rotating device for the rotation of the shaft would have been a mere matter of obvious design choice involves only routine skill in the art.

Regarding claim 7, although Keightley lack an inclusion of a pentaprism for bending the light beam, the use of an optics element for directing/redirecting light beam(s) in an optical system would have been obvious to one of ordinary skill in the art. It would have been obvious to modify Keightley accordingly in order to provide a more control to the scanning operation of the system.

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Regarding claims 11 and 12, although Keightley fails to disclose means for install and/or remove a sheet of film with the writing platen and/or surface as claimed, selecting a particular manner for coupling/removing the film to the writing surface would have been obvious to one of ordinary skill in the art. It would have been obvious to modify Keightley accordingly in order to provide a better coupling/removing the film to and/or from the writing surface. This would provide a faster and better performance of the system.

Regarding claims 13 and 14, although Keightley fails to disclose a line start detector and a knife edge for the system, using a line start detector and a knife edge in a scanning system would have been obvious to one of ordinary skill in the scanning art. It would have been obvious to modify Keightley accordingly in order to provide a more reliable performance of the image transfer system. The inclusion of a collimating lens would have also been obvious for similar reasons set forth above.

With respect to claims 15-19, although Keightley fails to disclose a plurality of light sources for providing a plurality of light beams, the use of a single or a plural light sources for providing a plurality of light beams would have been obvious to one of ordinary skill in the optics art in order to provide a compact optics design for the system. It would have been obvious to modify the proposed system of Keightley, discussed above, accordingly in order to provide a more convenience in aligning the optics components of the system.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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I) Shinada 5,502,709 discloses an image recording system having a plurality of light sources.

II) Genovese 5,319,393 discloses an optical scanning system having a rotatable element with multiple reflective surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Que T. Le whose telephone number is (703) 308-4830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Que T Le
Primary Examiner
Art Unit 2878